

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed July 30, 2008. At the time of the Office Action, Claims 1-20 were pending in this Application. Claims 1-20 were rejected. Claims 1, 8, and 15 have been amended. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102

Claims 1, 4-6, 8, and 11-13 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,399,941 issued to Michael G. Grothaus et al. (“*Grothaus*”). Applicant respectfully traverse and submits the cited art does not teach all of the elements of the claimed embodiment of the invention.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “the identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the art cited as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

Applicant amended independent claim 1 to include the limitation that the optical waveguide is arranged such that the ignition light exits transversely into a space defined between said electrodes with respect to the electrical field that is produced by said opposite electrodes. this limitation is disclosed in the originally submitted specification, for example, on page 11, paragraph [0030] and Fig. 2. Thus, no new matter has been introduced.

Applicant amended independent claim 8 to include the limitation that an exit of the optical waveguide is arranged between the mutually opposite electrodes. This limitation also disclosed in the originally submitted specification, for example, on page 11, paragraph [0030] and in particular shown in Fig. 2. Thus, no new matter has been introduced.

Grothaus teaches that the pseudospark discharge is initiated when ultraviolet light is trained upon each cathode aperture. Thus, *Grothaus* discloses a pseudospark switch in which in one embodiment light is introduced to respective holes 34 in cathodes from the backsides of the cathodes. Thus, the light cannot enter the space between the cathode and anode transversely. Moreover, the exit of the optical waveguide is not arranged between the electrodes but rather above one of the electrodes. To this end, Fig. 4, shows that the light 22 only enters the hole 34. See also, *Grothaus*, col. 4, lines 20-26. The second embodiment of *Grothaus* as shown in Fig. 5, makes it even more clear that *Grothaus* merely teaches to guide a light beam to an aperture in the cathode of the switch. In this second embodiment, light 22 enters hole 34 through the cathode itself.

Hence, none of the embodiments of *Grothaus*, discloses an apparatus in which the optical waveguide is arranged such that the ignition light which emerges from the optical waveguide enters the area which is bounded by the electrodes.

Therefore, all independent claims 1 and 8 are allowable with respect to *Grothaus*. Applicant respectfully submits that the dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicant respectfully requests reconsideration and allowance of the dependent Claims. Applicant reserves the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §102 or §103(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.

Rejections under 35 U.S.C. §103

Claims 2, 9, 15, and 17-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Grothaus* in view of the Applicant's Admitted Prior Art ("*AAPA*"). Applicant respectfully traverses and submit the cited art combinations, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

Claims 3 and 10 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Grothaus* in view of U.S. Patent 7,154,922 issued to Osamu Hattori ("*Hattori*"). Applicant

respectfully traverses and submit the cited art combinations, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

Claims 7 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Grothaus* in view of U.S. Patent 5,838,115 issued to Markus Jung et al. (“*Jung*”). Applicant respectfully traverses and submit the cited art combinations, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

Claim 16 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Grothaus* in view of *AAPA* as applied to Claim 15 above, and further in view of *Hattori*. Applicant respectfully traverses and submit the cited art combinations, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

Claim 20 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Grothaus* in view of *AAPA* as applied to Claim 15 above, and further in view of *Jung*. Applicant respectfully traverses and submit the cited art combinations, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int’l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

Applicant amended independent claim 15 to include the limitation that an exit of the optical waveguide is arranged between the mutually opposite electrodes. This limitation also disclosed in the originally submitted specification, for example, on page 11, paragraph [0030] and in particular shown in Fig. 2. Thus, no new matter has been introduced.

The same arguments as presented above with respect to claim 8, therefore also apply to claim 15. Hence, independent claim 15 is allowable with respect to *Grothaus*. Applicant respectfully submits that the dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicant respectfully requests reconsideration and allowance of the dependent Claims. Applicant reserves the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §103(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.

CONCLUSION

Applicant has now made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicant respectfully requests reconsideration of all pending Claims.

Applicant believes there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2545.

Respectfully submitted,
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Date: September 23, 2008

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